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Gee Whiz Domains, Inc.

UNITED STATES DISTRICT COURT

DISTRICT OF NEVADA

GREGORY RICKS, an individual)	Case No.: 2:08-cv-01174-PMP-GWF
)	
Plaintiff/Counterdefendant,)	
)	ANSWER TO SECOND AMENDED
vs.)	COUNTERCLAIM FOR
BMEZINE.COM, LLC, a Nevada limited liability)	DAMAGES, INJUNCTIVE, AND
company)	DECLARATORY RELIEF
)	
Defendant/Counterclaimant)	

BMEZINE.COM, LLC, a Nevada limited liability
company

Third Party Plaintiff,

vs.

GEE WHIZ DOMAINS, INC., a Nevada
corporation

Third Party Defendant.

Plaintiff/Counterdefendant Gregory Ricks (“Plaintiff” or “Ricks”) and Third Party
Defendant Gee Whiz Domains, Inc. (“Third Party Defendant” or “Gee Whiz”) by and through
their attorney of record, Weide & Miller, Ltd., hereby responds to the Second Amended
Counterclaim for Damages, Injunctive Relief and Declaratory Relief filed by

RRG-w-1430

1 Defendant/Counterclaimant/Third Party Plaintiff, Bmezine.com, LLC (“Defendant” or
2 “Bmezine”) and admits, denies and alleges as follows:

3 **I. INTRODUCTION**

4 1. Ricks and Gee Whiz state that paragraph 1 raises no allegations that can be
5 admitted or denied. To the extent a response is deemed required, the averments are denied.

6 **II. JURISDICTION AND VENUE**

7 2. Ricks and Gee Whiz are without knowledge or information sufficient to form a
8 belief as to truth or falsity of the allegations contained in paragraph 2, and therefore specifically
9 and generally deny the same.

10 3. Ricks admits that he has filed an original action in this district. Otherwise, Ricks
11 and Gee Whiz specifically and generally deny the remaining allegations contained in paragraph
12 3.

13 **III. THE PARTIES**

14 4. Ricks and Gee Whiz are without knowledge or information sufficient to form a
15 belief as to truth or falsity of the allegations contained in paragraphs 4 - 6, and therefore
16 specifically and generally deny the same.

17 5. Ricks admits that he was the registrant of BME.COM since March 6, 2000,
18 before the domain was hijacked by Defendant. Otherwise, Ricks and Gee Whiz specifically and
19 generally deny the remaining allegations contained in paragraph 7.

20 6. Ricks admits that a URDP arbitration panel awarded the BME.COM domain
21 name to Defendant. Otherwise, Ricks and Gee Whiz specifically and generally deny the
22 remaining allegations contained in paragraph 8.

23 7. Ricks and Gee Whiz specifically and generally deny the allegations contained in
24 paragraphs 9 through 14.

25 8. Ricks and Gee Whiz admit paragraph 15.

26 9. Ricks and Gee Whiz state that paragraph 16 raises no allegations that can be
27 admitted or denied.

1 10. Ricks and Gee Whiz are without knowledge or information sufficient to form a
2 belief as to truth or falsity of the allegations contained in paragraphs 17 - 34, and therefore
3 specifically and generally deny the same.

4 11. Ricks admits that he owns BME.US. Otherwise, Ricks and Gee Whiz
5 specifically and generally deny the remaining allegations contained in paragraph 35.

6 12. Ricks and Gee Whiz specifically and generally deny the allegations contained in
7 paragraphs 36 through 42.

8 13. Ricks and Gee Whiz state that paragraph 43 raises no allegations that can be
9 admitted or denied. To the extent a response is deemed required, the averments are denied.

10 14. Ricks and Gee Whiz specifically and generally deny the allegations contained in
11 paragraphs 44 through 53.

12 15. Ricks and Gee Whiz state that the paragraph 54 raises no allegations that can be
13 admitted or denied. To the extent a response is deemed required, the averments are denied.

14 16. Ricks and Gee Whiz specifically and generally deny the allegations contained in
15 paragraphs 55 through 64.

16 17. Ricks and Gee Whiz are without knowledge or information sufficient to form a
17 belief as to truth or falsity of the allegations contained in paragraph 65, and therefore
18 specifically and generally deny the same.

19 18. Ricks and Gee Whiz specifically and generally deny the allegations contained in
20 paragraph 66.

21 19. Ricks and Gee Whiz specifically and generally deny the allegations contained in
22 paragraph 67. Ricks and Gee Whiz state that the referenced exhibit speaks for itself.

23 20. Ricks and Gee Whiz specifically and generally deny the allegations contained in
24 paragraphs 68 through 89.

25 **FIRST CLAIM FOR RELIEF**

26 **Cybersquatting – 15 U.S.C. § 1125(d)**

27 21. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
28 answers to the allegations referenced in paragraph 90.

1 22. Ricks and Gee Whiz state that paragraph 91 raises no allegations that can be
2 admitted or denied. To the extent a response is deemed required, the averments are denied.

3 23. Ricks and Gee Whiz specifically and generally deny the allegations contained in
4 paragraphs 92 through 96.

5 **SECOND CLAIM FOR RELIEF**

6 **Trademark Infringement under 15 U.S.C. § 1125(a)**

7 24. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
8 answers to the allegations referenced in paragraph 97.

9 25. Ricks and Gee Whiz state that paragraph 98 raises no allegations that can be
10 admitted or denied. To the extent a response is deemed required, the averments are denied.

11 26. Ricks and Gee Whiz specifically and generally deny the allegations contained in
12 paragraphs 99 through 103.

13 **THIRD CLAIM FOR RELIEF**

14 **Willful Trademark Infringement under 15 U.S.C. § 1114(1)**

15 27. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
16 answers to the allegations referenced in paragraph 104.

17 28. Ricks and Gee Whiz state that paragraph 105 raises no allegations that can be
18 admitted or denied. To the extent a response is deemed required, the averments are denied.

19 29. Ricks and Gee Whiz are without knowledge or information sufficient to form a
20 belief as to truth or falsity of the allegations contained in paragraphs 106 through 107, and
21 therefore specifically and generally deny the same.

22 30. Ricks and Gee Whiz specifically and generally deny the allegations contained in
23 paragraphs 108 through 113.

24 **FOURTH CLAIM FOR RELIEF**

25 **False Designation of Origin**

26 31. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
27 answers to the allegations referenced in paragraph 114.

28 32. Ricks and Gee Whiz state that paragraph 115 raises no allegations that can be

1 admitted or denied. To the extent a response is deemed required, the averments are denied.

2 33. Ricks and Gee Whiz specifically and generally deny the allegations contained in
3 paragraphs 116 through 118.

4 **FIFTH CLAIM FOR RELIEF**

5 **Unfair Competition**

6 34. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
7 answers to the allegations referenced in paragraph 119.

8 35. Ricks and Gee Whiz specifically and generally deny the allegations contained in
9 paragraphs 120 through 135.

10 **SIXTH CLAIM FOR RELIEF**

11 **Nevada Common Law Trademark Infringement**

12 36. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
13 answers to the allegations referenced in paragraph 136.

14 37. Ricks and Gee Whiz are without knowledge or information sufficient to form a
15 belief as to truth or falsity of the allegations contained in paragraph 137, and therefore
16 specifically and generally deny the same.

17 38. Ricks and Gee Whiz specifically and generally deny the allegations contained in
18 paragraphs 138 through 139.

19 **SEVENTH CLAIM FOR RELIEF**

20 **Deceptive Trade Practices under N.R.S. § 598.0915**

21 39. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
22 answers to the allegations referenced in paragraph 140.

23 40. Ricks and Gee Whiz specifically and generally deny the allegations contained in
24 paragraphs 141 through 142.

25 **EIGHTH CLAIM FOR RELIEF**

26 **Intentional Interference with Prospective Economic Advantage**

27 41. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
28 answers to the allegations referenced in paragraph 143.

1 42. Ricks and Gee Whiz specifically and generally deny the allegations contained in
2 paragraphs 144 through 149.

3 **NINTH CLAIM FOR RELIEF**

4 **Trademark Infringement under the Fla. Stat. § 495.131**

5 43. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
6 answers to the allegations referenced in paragraph 150.

7 44. Ricks and Gee Whiz state that paragraph 151 raises no allegations that can be
8 admitted or denied.

9 45. Ricks and Gee Whiz specifically and generally deny the allegations contained in
10 paragraphs 152 through 154.

11 **TENTH CLAIM FOR RELIEF**

12 **Dilution Under the Fla. Stat. § 495.151**

13 46. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference their
14 answers to the allegations referenced in paragraph 155.

15 47. Ricks and Gee Whiz state that paragraph 156 raises no allegations that can be
16 admitted or denied.

17 48. Ricks and Gee Whiz are without knowledge or information sufficient to form a
18 belief as to truth or falsity of the allegations contained in paragraph 157, and therefore
19 specifically and generally deny the same.

20 49. Ricks and Gee Whiz specifically and generally deny the allegations contained in
21 paragraphs 158 through 161.

22 **ELEVENTH CLAIM FOR RELIEF**

23 **Declaratory Judgment, 28 U.S.C § 2201 et. seq.**

24 50. 162. Ricks and Gee Whiz hereby repeat, reallege, and incorporate by reference
25 their answers to the allegations referenced in paragraph 162.

26 51. Ricks and Gee Whiz admit that as of May 22, 2009, Defendant has control over
27 the <bme.com> domain name. Otherwise, Ricks and Gee Whiz specifically and generally deny
28 the remaining allegations contained in paragraph 163.

1 52. Ricks and Gee Whiz admit that there is an actual controversy between the parties
2 regarding the <bme.com> and <bme.us> domain names. Otherwise, Ricks and Gee Whiz
3 specifically and generally deny the remaining allegations contained in paragraph 164.

4 53. Ricks and Gee Whiz specifically and generally deny the allegations contained in
5 paragraph 165.

6 **ANSWER TO PRAYER FOR RELIEF**

7 54. Ricks and Gee Whiz deny that Defendant is entitled to the judgment and relief
8 prayed for in paragraphs 1 through 6 and D through F.

9 **AFFIRMATIVE DEFENSES**

10 Ricks and Gee Whiz hereby assert the following Affirmative Defenses:

11 1. Defendant's claims, in whole or in part, fail to state a claim upon which relief can
12 be granted.

13 2. Defendant's claims are barred, in whole or in part, by the doctrine of laches.

14 3. Defendant's claims are barred, in whole or in part, by the doctrine of estoppel.

15 4. Defendant's claims are barred, in whole or in part, by the doctrine of
16 acquiescence.

17 5. Defendant's claims are barred, in whole or in part, by the doctrine of waiver.

18 6. Defendant's claims are barred, in whole or in part, by the doctrine of fair use.

19 7. Defendant's claims are barred, in whole or in part, by the doctrine of unclean
20 hands.

21 8. Defendant's claims are barred, in whole or in part, by the doctrine of assumption
22 of the risk.

23 9. Defendant's claims are barred, in whole or in part, by applicable statute of
24 limitations.

25 10. Defendant's claims are barred because Ricks and/or Gee Whiz have superior
26 rights to the marks in question.

27 11. Ricks and Gee Whiz deny that they have engaged in any acts of cybersquatting,
28 trademark infringement, false designation of origin, unfair competition, trademark dilution,

1 deceptive trade practices, or interference with prospective economic advantage.

2 12. Defendant has not been damaged directly, indirectly, proximately or in any
3 manner whatsoever by any conduct of Ricks and Gee Whiz.

4 13. Any injuries or damages sustained by Defendant as alleged in the Counterclaims
5 are the result of the conduct of a third-party over which Ricks and Gee Whiz had no control.

6 14. The allegations contained in the Counterclaims, and the resulting damage, if any,
7 to Defendant, were caused or contributed to, in whole or in part, by Defendant's own actions
8 and not by the actions undertaken by Ricks and Gee Whiz

9 15. Defendant's alleged damages are the direct and proximate result of its own
10 negligent or intentional conduct or malfeasance.

11 16. Defendant lacks standing to assert its counterclaims.

12 17. Defendant has suffered no injury nor is there a likelihood of injury.

13 18. Ricks and Gee Whiz aver that Defendant has not been damaged in any amount,
14 manner, or at all by reason of any act alleged against Ricks and Gee Whiz in the counterclaims,
15 and therefore, the relief prayed for in the counterclaims cannot be granted.

16 19. Assuming without admitting that the counterclaims state a claim upon which
17 relief can be granted, Defendant has failed to mitigate its damages, if any.

18 20. Assuming without admitting that any infringement occurred, Defendant's
19 damages are limited by principles of equity under the Lanham Act, 15 U.S.C. §1117.

20 21. Defendant's claims are barred, in whole or in part, since there is no likelihood of
21 confusion in the market place.

22 22. Defendant has failed to protect and/or enforce its alleged trademark rights.

23 23. Defendant's claims constitute trademark misuse and illegal anti-competitive
24 conduct for which Defendant should forfeit whatever trademark rights it has in trademarks at
25 issue.

26 24. At all times, Ricks and Gee Whiz have acted in a commercially reasonable and
27 lawful manner.

28 25. Ricks registered the domain names at issue in good faith and without any intent

1 to profit from any claimed trademark rights owned by Defendant.

2 26. Gee Whiz has not registered, trafficked in or used any of the domain names at
3 issue.

4 27. Defendant is estopped from asserting its cybersquatting counterclaims because
5 the trademark at issue was not distinctive or famous at the time Ricks registered the domain
6 names.

7 28. Defendant is estopped from asserting its trademark-related counterclaims as the
8 trademarks allegedly infringed are not protectable.

9 29. Defendant is estopped from asserting its trademark-related counterclaims as the
10 trademarks allegedly infringed are used as a “familiar expression.”

11 30. Defendant is estopped from asserting its trademark-related counterclaims as the
12 trademarks allegedly infringed are generic and incapable of being infringed.

13 31. Defendant is estopped from asserting its trademark-related counterclaims as the
14 trademarks allegedly infringed are descriptive and Defendant has not acquired distinctiveness in
15 said trademarks.

16 32. Defendant is estopped from asserting its trademark-related counterclaims as
17 Defendant has failed to continuously use the trademarks alleged to have been infringed.

18 33. Defendant is estopped from asserting its trademark-related counterclaims as
19 Defendant has not exclusively or reasonably exclusively used the trademarks alleged to have
20 been infringed.

21 34. Defendant is estopped from asserting its trademark-related counterclaims as
22 Defendant does not own the trademarks at issue.

23 35. Defendant is estopped from asserting its trademark-related counterclaims as
24 Defendant has not acquired trademark rights to the trademarks at issue under the cited federal,
25 state, and/or common law.

26 36. Defendant is estopped from asserting its trademark-related counterclaims as
27 Defendant has failed to continuously use the trademarks alleged to have been infringed.

28 37. Ricks and Gee Whiz hereby incorporate by reference those affirmative defenses

1 enumerated in Rule 8 of the Federal Rules of Civil Procedure as if fully set forth herein. In the
2 event further investigation or discovery reveals the applicability of any such defenses, Ricks and
3 Gee Whiz reserve the right to seek leave of court to amend this Answer to Defendant's
4 Counterclaims to specifically assert any such defense. Such defenses are herein incorporated by
5 reference for the specific purpose of not waiving any such defenses.

6 38. Pursuant to Rule 11 of the Federal Rules of Civil Procedure, all possible
7 affirmative defenses may not have been alleged herein insofar as sufficient facts were not
8 available after reasonable inquiry upon filing of this answer to the Defendant's Counterclaims,
9 and Ricks and Gee Whiz reserve the right to amend this Answer to Defendant's Counterclaims
10 as additional information becomes available.

11 **PRAYER FOR RELIEF**

12 WHEREFORE, having answered Defendant's Counterclaims, Ricks and Gee Whiz pray
13 for judgment as follows:

- 14 (i) That Defendant take nothing by reason of its Counterclaims;
15 (ii) That the Counterclaims be dismissed against Ricks and Gee Whiz with prejudice;
16 (iii) For all attorneys fees incurred in the defense of said Counterclaims
17 (iv) For costs and disbursements incurred herein; and
18 (v) For such other further relief as the court may deem just and proper.

19
20 DATED this 22nd day of June, 2009.

21 Respectfully Submitted,

22 **WEIDE & MILLER, LTD.**

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24 

25 Mark Borghese, Esq.
26 Ryan Gile, Esq.
27 7251 W. Lake Mead Blvd., Suite 530
28 Las Vegas, NV 89128
Attorneys for Gregory Ricks and
Gee Whiz Domains, Inc.

CERTIFICATE OF SERVICE

I am a resident of and employed in Clark County, Nevada. I am over the age of 18 years and not a party to the within action. My business address is: 7251 West Lake Mead Blvd., Suite 530, Las Vegas, Nevada, 89128.

On **June 22, 2009**, I served this document on the parties listed on the attached service list via one or more of the methods of service described below as indicated next to the name of the served individual or entity by a checked box:

PERSONAL SERVICE: by personally hand-delivering or causing to be hand delivered by such designated individual whose particular duties include delivery of such on behalf of the firm, addressed to the individual(s) listed, signed by such individual or his/her representative accepting on his/her behalf. A receipt of copy signed and dated by such an individual confirming delivery of the document will be maintained with the document and is attached.

E-MAIL / E-FILE: Automatically through the court's electronic filing system or by transmitting a copy of the document to the electronic-mail address designated by the attorney or the party who has filed a written consent for such manner of service.

FAX SERVICE: by transmitting to a facsimile machine maintained by the attorney or the party who has filed a written consent for such manner of service.

MAIL SERVICE: by placing a true copy thereof enclosed in a sealed envelope with postage thereon fully prepaid, in the United States mail at Las Vegas, Nevada. I am readily familiar with the firm's practice of collection and processing correspondence by mailing. Under that practice, it would be deposited with the U.S. Postal Service on that same day with postage fully prepaid at Las Vegas, Nevada in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing an affidavit.

I declare that under penalty of perjury under the laws of the State of Nevada that the above is true and correct. I further declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

/s/ Ryan Gile

An employee of WEIDE & MILLER, LTD.

SERVICE LIST

ATTORNEYS OF RECORD	PARTIES REPRESENTED	METHOD OF SERVICE
Mark G. Tratos, Esq. Donald L. Prunty, Esq. Ronald D. Green, Jr., Esq. GREENBERG TRAURIG, LLP 3773 Howard Hughes Parkway Suite 400 North Las Vegas, NV 89169	Defendant/Counterclaimant/ Third Party Plaintiff	<input type="checkbox"/> Personal service <input checked="" type="checkbox"/> Email / E-File <input type="checkbox"/> Fax service <input type="checkbox"/> Mail service
Lawrence G. Walters, Esq. Marc J. Randazza, Esq. WESTON, GARROU, WALTERS & MOONEY 781 Douglas Avenue Altamonte Springs, FL 32714	Defendant/Counterclaimant/ Third Party Plaintiff	<input type="checkbox"/> Personal service <input checked="" type="checkbox"/> Email / E-File <input type="checkbox"/> Fax service <input type="checkbox"/> Mail service